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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,257	12/20/1999	ANGELA K. HANSON	10990314-1	3407

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EXAMINER

VEILLARD, JACQUES

ART UNIT PAPER NUMBER

2175

DATE MAILED: 06/12/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/468,257

Applicant(s)
Angela K. Hanson et al.

Examiner
Jacques Veillard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 5, 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 7-24 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15, 22, and 24 is/are allowed.
- 6) ☒ Claim(s) 2-5, 7-14, 16-21, and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

JAN RIMEK
JANUARY EXAMINER
AU 2175

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DETAILED ACTION

1. This in response to the Applicant's amendment filed on 4/5/2002.
2. Claims 1 and 6 have been canceled without prejudice or disclaimer.
3. Claims 2-5, and 7-20 have been amended and rewritten, and claims 21-24 added.
4. Claims 2-5, and 7-24 are pending and presented for examination.

Response to Arguments

5. Applicant's arguments with respect to claims 2-5, and 7-24 have been considered but are moot in view of the new ground(s) of rejection as set forth below.

Claim Rejections - 35 USC § 103

6. Claims 2-5, 7-14, 16-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merchant et al.(U. S. Pat. No. 5,422,733, and hereinafter Merchant) in view of Bloomfield (U. S. Pat. No. 6,023,345).

As per claims 5 and 20, Merchant teaches a method and apparatus facsimile communication with capability of transmitting address and message information (See col.1, lines 14-18). Similarly, the method taught by Merchant comprising the steps of: locating a communication mark, if one is present, on a medium containing information (See col.5, lines 3-6,

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and col.12, lines 39-42); obtaining at least one communication address directly or indirectly from said communication mark (See col.5, lines 23-29).

Merchant does not explicitly teach inputting said communication address into an address function of a communication device; and initiating a communication of said information to said address through said communication device; wherein said communication mark includes a first communication address for a first a first communication mode, and a second communication address for a second different type of communication mode.

Bloomfield, in the same endeavor teaches a facsimile to E-mail communication system (See the Title, and col.1, lines 18-22) includes the features of: inputting said communication address into an address function of a communication device (See col.8, lines 30-67 to col.9, lines 1-37); and initiating a communication of said information to said address through said communication device (See col. 2, lines 46-62, col.9, lines 50-56, and col..18, lines 41-56); wherein said communication mark includes a first communication address for a first a first communication mode (See Figs 1 and 7, elements 102, 106, and 110 (e.i., the Fax system)) and a second communication address for a second different type of communication mode (See Figs 1 and 7, elements 112, 116, 118, and 120 (e.i., the E-mail system)).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Merchant with the teachings of Bloomfield to include a local interface and a remotely located fax/e-mail server system (FEM- Gateway) with the motivation of providing Facsimile/E-mail service whereby hardcopy information, including

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textual and/or graphical, is communicated between a facsimile device and an E-mail device, while still allowing conventional operation of the facsimile device (See col.2, lines 11-17).

As per claims 11, 21, and 23, they claims have substantially the same limitations as claims 5, and 20, except for the limitation wherein said communication mark is stored to a location where a communication address is stored. This limitation would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention in view of Bloomfield, because Bloomfield teaches a fax to E-mail system suggesting a database storage wherein faxes and E-mail addresses can be stored and retrieved at later time (See col.18, lines 17-24, and lines 62-64; col.19, lines 10-25). Therefore, they are rejected as previously discussed in claims 5 and 20 rejection above.

As per claim 2, Merchant teaches the claimed invention limitations, wherein said locating step comprises scanning said medium (See Fig.1 element 14, and col.3, lines 66-67).

As per claim 3, Merchant teaches the claimed invention limitations, wherein said locating step comprises the step of locating said communication mark at a predetermined location on said medium (col. 6, lines 60-63 and col.9, lines 12-26).

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As per claim 4, Merchant teaches the claimed invention limitations, wherein said locating step comprises locating an address relative to a predetermined mark on said medium (See col.9, lines 27-36).

As per claim 7, Bloomfield teaches the claimed invention limitations, wherein said communication device comprises at least two communication modes (See Figs.1 and 7, elements 102, 106, and 110 (e.i., the Fax system) and elements 112, 116, 118, and 120 (e.i., the E-mail system)).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Merchant with the teachings of Bloomfield to include a local interface and a remotely located fax/e-mail server system (FEM- Gateway) with the motivation of providing Facsimile/E-mail service whereby hardcopy information, including textual and/or graphical, is communicated between a facsimile device and an E-mail device, while still allowing conventional operation of the facsimile device (See col.2, lines 11-17).

As per claim 8, Merchant teaches the claimed invention limitations, further comprising the step of adding a communication mark to said information prior to initiating said communication (See Merchant's col.3, lines 63- 66). Merchant clearly shows that by adding a drawing, graphic or pictorial to the information document.

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As per claims 9 and 10, the combination of Merchant and Bloomfield does not explicitly teach a method wherein said communication mark is a bar code that is not visible to the unaided human eye. However, this limitation would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention in view of Merchant, because Merchant teaches facsimile communication suggesting an encoder system using encoding technique according Standard Code for information interchange which are not visible to unaided human eye equivalent to a barcode system (See col.5, lines 29-34, and lines 39-44). The process of encoding system taught by Merchant is to prevent unauthorized access of services, especially during transmission.

As per claim 12, Bloomfield teaches the claimed invention limitations, further comprising the step of accessing said address over a network (See Fig.3, and col.7, lines 35-65).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Merchant with the teachings of Bloomfield to include an e-mail network interface with the motivation of accessing the e-mail address over a network (See col.7, lines 35-45).

As per claim 13, Merchant teaches the claimed invention limitations, further comprising the step of accessing a URL address wherein said address is located (See col.1, lines 21-24).

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As per claim 14, Merchant teaches the claimed invention limitations, wherein said communication device is a voice communication device (See Merchant's col.1, lines 21-26).

As per claim 16, Merchant, teaches the claimed invention limitations, further comprising the step of storing said address obtained directly or indirectly from said communication mark (See col.7, lines 16-21).

As per claim 17, Merchant teaches the claimed invention limitations, further comprising the steps of determining a name of an addressee corresponding to said obtained address (See col.6, lines 63-68 to col.7, line 1); and displaying said address name to a user (See col.7, lines 1-4).

As per claim 18, Merchant teaches the claimed invention limitations, further comprising the step of adding a new communication mark to said information that includes directly or indirectly a new address to be obtained relative to said obtained at least one address (See col.3, lines 58-67). Merchant shows a new communication mark to the source document information by a written text such as a handwritten message.

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As per claim 19, Merchant teaches the claimed invention limitations, further comprising the step of adding a new communication mark to said information that deletes an address or a reference to an address from a located communication mark (See col.8, lines 62-68 to col.9, lines 1-11). Merchant shows a type information which a handwritten letters, characters, and symbols entered into the fixed field of the first format region and encoded ASCII text. The type information is, for example, characterized as an address reference for the selective call receiver to be paged other system information.

Allowable Subject Matter

7. Claims 15, 22, and 24 are allowed over the prior of record.
8. The following is a statement of reasons for the indication of allowable subject matter:

As regard to claims 15, 22, and 24, Applicant's particular disclosure relates to automated document management system, specially to a device and method for automatically determining an address where a communication is to be sent and the communication mode by which is to be sent, comprising the steps of: determining if the communication mode for the first communication address is available at the communication device, and when it is determined that the communication mode for the first communication address is not available at the communication device, sending the second communication address for the second different type of communication mode and the information to the communication device. The closest prior art Merchant et al.(U. S. Pat. No. 5,422,733) and Bloomfield (U. S. Pat. No. 6,023,345) teach a

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facsimile communication system but they both fail to teach or suggest a system: determining if the communication mode for the first communication address is available at the communication device, and when it is determined that the communication mode for the first communication address is not available at the communication device, sending the second communication address for the second different type of communication mode and the information to the communication device as recited in claims 15, 22, and 24.

Other Prior Art Made Of Record

9. Gurd et al.(U. S. Pat. No. 4,860,250) discloses a data packet for shortening data packets passed between first and second devices,

Luzeski et al.(U. S. Pat. No. 6,301,245) discloses a Universal Messaging system provides e-mail, voice-mail and fax-mail services to subscribers that may utilize the Internet to access their messages, and

Pieterse (U. S. Pat. No. 6,088,127) discloses a device for receiving and forwarding fax messages with control information and other information, wherein control information comprises destination address information and transmission priority code.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CAR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CAR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. **Any response to this action should be mail to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 746-7238 (for formal communication intended for entry)

Or:

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(703) 746-7240(for informal of draft communications, please label


“PROPOSED” or “DRAFT”)

Hand - delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington.

VA, Fourth Floor (Receptionist).

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques Veillard whose telephone number is (703) 305-7094. The examiner can normally be reached Monday through Friday from 9:30 AM to 4: 30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dov Popovici, can be reached on (703) 305-3830. The fax phone number for this group is (703) 308-5403.


Jacques Veillard
Patent Examiner

June 10, 2002

SAM RINELL
PRIMARY EXAMINER
AU 2175